

### **REMARKS**

Claim 15 has been amended based on, e.g., the disclosure in the Examples and the lower limit disclosure at page 10, line 3 in the specification, particularly in view of the holding in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) as discussed in the first paragraph of MPEP 2163.05 III. Claim 19 has been amended to resolve an objection raised by the Examiner. Claim 26 has been amended in view of the amendment of claim 15 and based on, e.g., the 2% by mass disclosure at page 10, line 3 in the specification.

Entry of the above amendment is respectfully requested.

### **Objection to Claim 19**

On page 2 of the Office Action, the Examiner indicates that if claim 18 is found allowable, claim 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

In response, Applicants have amended claim 19 to recite that the tocopherol alkylglycine ester is a  $\gamma$ -tocopherol alkylglycine ester to resolve this issue.

Accordingly, Applicants submit that this objection has been overcome, and withdrawal of this objection is respectfully requested.

### **Obviousness Rejections**

On page 3 of the Office Action, claims 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (Free Rad. & Med., 1997, 22(5), pages 761-769) in view of

Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100) and Yasuaki (JP 62- 106005). Also, on page 3 of the Office Action, claims 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. (Nutrition and Cancer, 2000, 38(1), pages 87-97) in view of Takata et al. (J. Pharm. Sci., 1995, 84(1), pages 96-100).

In response, Applicants note initially that the Examiner indicates at the top of page 5 of the Office Action that the data of record does demonstrate that lotions with 2.0 wt% of d,l- $\alpha$ -, d- $\alpha$ -, d- $\gamma$ -, and d- $\delta$ - tocopherol dimethylglycine ester hydrochloride unexpectedly reduce pigmentation of skin when applied to the skin after UV exposure.

Applicants thank the Examiner for this indication, and have amended claim 26 so that it is specifically directed to subject matter which the Examiner indicates as providing unexpected results. Accordingly, Applicants submit that claim 26 is directed to allowable subject matter, and Applicants respectfully request that the Examiner indicate this in the next communication from the PTO.

In addition, Applicants submit herewith an unexecuted Rule 132 Declaration demonstrating the unexpected superiority of the presently claimed invention. The executed Declaration will be submitted promptly after it is received.

Further, Applicants wish to present the following additional experimental results. Applicants are in the process of preparing another Rule 132 Declaration including this additional experimental evidence.

Compound	Conc. (%)	Evaluation Point <sup>1)</sup>
d- $\gamma$ -tocopherol dimethyl glycine ester hydrochloride	0.1	3
	0.3	2
	0.5	2
d- $\alpha$ -tocopherol dimethyl glycine ester hydrochloride	0.1	3
	0.3	2
	0.5	2

1) Based on the criteria shown on page 21 of the specification, as the "Evaluation Point" indicates, the lotion containing the compounds shown in the above Table at the level of 0.3% exhibited unexpectedly superior results as compared with the level of 0.1%, namely, "Evaluation Point 2" at 0.3% compared with "Evaluation Point 3" at 0.1%. Therefore, these data support the unexpected superiority of lower limit of the range of the compounds in the claimed composition.

Thus, Applicants submit that the present invention is not obvious over the cited art, and withdrawal of these rejections is respectfully requested.

### Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)  
U.S. Application No.: 10/506,335

Attorney Docket No.: Q68931

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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